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| In re Application of | : | SPECIAL PROGRAMS OFFICE |
| Bennett, et al. | : | DAC FOR PATENTS |
| Application No. 08/722,659 | : | DECISION ON PETITION |
| Filed: September 27, 1996 | : | |
| Attorney Docket No. 104385.140 | : | |

This is in response to the petition under 37 CFR 1.47, filed January 8, 1999, which has been treated as a petition under 37 CFR 1.183¹ to waive the requirement of 37 CFR 1.131 that the inventor of the subject matter of the rejected claim or the party qualified under §§ 1.42, 1.43 or 1.47 execute a the oath or declaration under 37 CFR 1.131.

The petition under 37 CFR § 1.183 is granted.

The petition states that Dr. Bennett has refused to sign the declaration pursuant to 37 CFR 1.131. A declaration of Richard Vickers, Ph.D., is filed in support of the petition. Dr. Vickers states that he spoke with Dr. Bennett on November 4, 1998, and that he understood that Dr. Bennett would sign the declaration. Dr. Vickers also states that he sent a letter to Dr. Bennett and later attempted to contact Dr. Bennett, and that on December 8, 1998, Dr. Bennett told him that he would not sign the declaration. Exhibit C to the Vickers declaration is a copy of a letter signed by Dr. Bennett, wherein Dr. Bennett states that, as he recalls, "the work was done before the dates of the listed publication."

37 CFR 1.131(a)(1) states, in part:

When any claim of an application or patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 ..., the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43 or 1.47, may submit an appropriate oath or

¹37 CFR § 1.47 applies when an application is filed without an oath or declaration signed by the inventor.

declaration to overcome the patent or publication.

The provisions of 37 CFR 1.47 do not apply because Dr. Bennett, the inventor who refuses to sign the § 1.131 declaration, signed the oath or declaration. Had Dr. Bennett refused to sign the oath or declaration for the patent application, § 1.131(a) would have permitted the other inventors to sign the declaration without an additional petition.

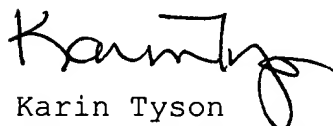
37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver.

Under the circumstances of this application, it is appropriate to waive the requirement of 37 CFR § 1.131 that the inventor of the claimed subject matter make the oath or declaration pursuant to § 1.131.

After mailing of this decision, the \$130.00 petition fee will be charged to deposit account No. 08-0219.

Thereafter, the application will be returned to Examining Group Art Unit 1816 for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-3159.



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